

25



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,430	08/13/2001	Patricia S. Kruse	10010789-1	9651

7590 03/23/2005  
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EXAMINER

MILIA, MARK R

ART UNIT PAPER NUMBER

2622

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/929,430

Applicant(s)

KRUSE, PATRICIA S.

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 1, reference characters "108" and "110", Fig. 4, reference character "412-4", Fig. 6, reference character "602", Fig. 7, reference characters "700", "702", "704", "706", "708", "710", and "712", and Fig. 8, reference character "808". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 7, 9-10, 15, 17-18, 23, 25-26, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6026416 to Kanerva et al.

Regarding claims 1 and 9, Kanerva discloses a method and computer-readable medium comprising adding a plurality of files to a presentation profile (see column 6 lines 11-38, column 10 lines 46-51, and column 12 line 40-column 13 line 42), specifying a set of packaging and a set of printing characteristics with respect to individual ones of the files (see column 26 lines 4-7, 16-21 and 57-63), and responsive to a single print request, printing each of the files in the presentation profile based on the packaging and printing characteristics (see column 25 lines 47-65).

Regarding claim 17, Kanerva discloses a computing device comprising a memory comprising computer-executable instructions for automatically printing each file in a presentation profile (see column 25 line 39-column 26 line 3), a processor that is operatively coupled to the memory, the processor being configured to fetch and execute the computer-executable instructions from the memory (see column 4 lines 51-65, column 6 lines 11-38, and column 6 line 55-column 7 line 25), the computer-executable instructions comprising instructions for adding a plurality of files to a presentation profile

(see (see column 6 lines 11-38, column 10 lines 46-51, and column 12 line 40-column 13 line 42), specifying a set of packaging and a set of printing characteristics with respect to individual ones of the files (see column 26 lines 4-7, 16-21 and 57-63), and responsive to a single print request, printing each of the files in the presentation profile based on the packaging and printing characteristics (see column 25 lines 47-65).

Regarding claim 25, Kanerva discloses a user interface comprising a first area for adding a plurality of files to a presentation profile (see Fig. 2, column 6 lines 16-38, and column 6 line 55-column 7 line 25, a second area for specifying a set of packaging characteristics with respect to individual ones of the files (see column 10 lines 46-51, column 17 lines 11-26, and column 18 lines 26-38), a third area for indicating a set of printing characteristics with respect to individual ones of the files (see column 26 lines 4-7 and 16-21), and a fourth area for printing each of the files in the presentation profile in response to a single print request, the printing being based on the packaging and printing characteristics (see column 25 lines 47-65).

Regarding claims 2, 10, 18, and 26, Kanerva discloses the system discussed in claims 1, 9, 17, and 25, and further discloses wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application (see column 6 lines 11-16, column 9 lines 28-34, column 10 lines 46-51, and column 13 lines 18-23).

Regarding claims 7, 15, 23, and 31, Kanerva discloses the system discussed in claims 1, 9, 17, and 25, and further discloses identifying a specific printer to print each of the files (see Figs. 1 and 2 and column 8 lines 56-57).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, 8, 11-14, 16, 19-22, 24, 27-30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanerva as applied to claims 1, 9, 17, and 25 above, and further in view of U.S. Patent No. 5481353 to Hicks et al.

Regarding claims 3, 11, 19, and 27, Kanerva does not disclose expressly identifying individual ones of the files that are not included in a general distribution package.

Hicks discloses identifying individual ones of the files that are not included in a general distribution package (see Figs. 3 and 4, reference shows transparencies, dividers, a master set, and handouts provided in four separate columns for use in a presentation, the handouts of the reference are analogous to the distribution package of the claim and therefore discloses by the reference).

Regarding claims 4, 12, 20, and 28, Kanerva does not disclose expressly selecting one or more options to identify how at least one subset of the files are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of tiles.

Hicks discloses selecting one or more options to identify how at least one subset of the files are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of tiles (see Figs. 3 and 4, column 8 lines 31-46, column 10 lines 6-28 and 56-67, and column 11 lines 1-6).

Regarding claims 5, 13, 21, and 29, Kanerva discloses indicating a number of copies to print with respect to at least a subset of the files (see column 26 lines 4-7).

Kanerva does not disclose expressly a subset of the files that are for general audience distribution.

Hicks discloses a subset of the files that are for general audience distribution (see Figs. 3 and 4 and column 9 lines 58-67).

Regarding claims 6, 14, 22, and 30, Kanerva discloses indicating a number of copies to print with respect to at least a first subset of the files that are independent of at least a second subset of the files (see column 26 lines 4-7).

Kanerva does not disclose expressly files that are for general audience distribution.

Hicks discloses files that are for general audience distribution (see Figs. 3 and 4 and column 9 lines 58-67).

Regarding claims 8, 16, 24, and 32, Kanerva does not disclose expressly indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files.

Hicks discloses indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files (see column 10 lines 10-19).

Kanerva & Hicks are combinable because they are from the same field of endeavor, printing multiple documents linked together to form a single print job.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the presentation distribution of documents technique of Hicks with the system of Kanerva.

The suggestion/motivation for doing so would have been to allow the combination of files of different formats to be printed, for means of a presentation, and eliminate the chance for interruption of printing by another print job because the "bound" files are printed as a single print job as well as the decrease in processing time and increase in efficiency.

Therefore, it would have been obvious to combine Hicks with Kanerva to obtain the invention as specified in claims 3-6, 8, 11-14, 16, 19-22, 24, 27-30, and 32.



**Conclusion**

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show state of the art refer to U.S. Patent number 5442732 (Matysek et al.) and U.S. Patent Application number 2003/0103237 (Han).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (703) 305-1900. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (703) 305-4712. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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